

REMARKS

Upon entry of this amendment, independent claim 1 with dependent claims 3-8 will be present in the application.

Claim 1 has been amended recite that the inner surface of the receptacle defines a clearance angle α having a value greater than zero with the second sidewall of the rod. As shown in Figure 1 of the subject application, the inner surface of the receptacle and the second sidewall of the rod define a gap having a clearance angle α . Since the gap and clearance angle are clearly shown in the Figure, clearance angle α must have a value greater than zero. If the value of clearance angle α was zero, no gap would be shown in Figure 1. Accordingly, the amendment does not introduce new matter.

Claims 1 and 3-8 were rejected under 35 U.S.C. § 112, first paragraph, the Office Action contending that "the numerical range of the clearance angle alpha has not been adequately disclosed in the specification."

As explained above, Figure 1 of the subject application shows that the inner surface of the receptacle and the second sidewall of the rod define a gap having a clearance angle α . Since the gap and clearance angle are clearly shown in the Figure, clearance angle α must have a value greater than zero. If the value of clearance angle α was zero, the inner surface of the receptacle and the second sidewall of the rod would be touching and no gap would be shown in Figure 1. To the inventors' knowledge, there is no optimum value for clearance angle α and clearance angle α may be set at any value greater than zero which is not so large which not adversely effect operation of the screen. If a person of ordinary skill in the art is advised of the clearance angle of the subject invention and the benefits provided thereby, it would be well within the purview of such person to determine the maximum value of clearance angle α for a screen intended for a specific use.

The Office Action also alleges that "it is not clear as to whether or not the clearance angle alpha is present only in an intermediate product, for example, in a planar intermediate product that is later bent into a non-planar/cylindrical configuration, or in the final product, for example, in a planar or cylindrical screen member." However, the Office Action acknowledges that the claimed invention may be either a flat screen or a cylindrical screen and that one way that the cylindrical screen may be manufactured is by bending a flat screen. The Applicants cannot understand why the Office Action assumes that a flat screen which is later bent into a cylindrical configuration will be any different from a flat screen which is utilized in a planar configuration. In either case, the inner surface of the receptacle and the second sidewalls of the rods of the screen will define a clearance angle α having a value greater than zero.

As taught on page 5, lines 9-21, of the subject specification, there are several ways that the subject screen may be assembled. The screen can be made "by pressing the rods together with the supporting elements until they lock into place. Another form of manufacture is to bend the supporting elements open elastically so that the receptacle 6 for the rods expand and the individual rods 1 can be inserted." In both cases, the rods are clamped within the supporting elements forming a screen "without plastic deformation of the individual components or additional connecting links, such as weld seams." In the Response to the Office Action of October 25, 2002, the Applicants explained that the clearance angle α limits the clamping force exerted by the supporting element, preventing the initiation of cracks in the supporting element. Accordingly, clearance angle α prevents crack initiation in the supporting element of both the flat and cylindrical screens. Although bending a flat screen to form a cylindrical screen increases the clamping force on the rods (page 5, lines 21-23), the crack initiation prevention function of clearance angle α is not restricted to cylindrical screens. No matter what final use is intended for the flat screen, clearance angle α will provide crack initiation protection for the supporting element of the screen.

Claims 1 and 3-8 were rejected under 35 U.S.C. § 103 as being unpatentable over EP 499154 (hereinafter "'154"), the Office action contending that '154 discloses a clearance angle α , where the value of clearance angle α is zero. The Applicants respectfully submit that such rejection has no basis in fact. Figure 1 and page 4, line 29, to page 5, line 3, of the specification define the term "clearance angle", as used in claim 1. None of the drawings of '154 disclose a gap or clearance between the inner surface of the receptacle and the second sidewall of the rod. Accordingly, '154 can not disclose a clearance angle as alleged by the Office Action. The allegation that '154 discloses a non-invisible clearance having an angle with a value of zero, is improper. If such a rejection were proper, every claim of every mechanical patent application would be anticipated by any relevant prior art since such prior art would necessarily include the invisible elements recited in the claims of the new application but not actually shown in the figures of the prior art patent. MPEP § 706.02(j) states "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." See also MPEP §§ 2142 and 2143. The Board of Patent Appeals and Interferences has held that "deeming does not discharge him [the examiner] from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness." Ex parte Stern, 13 USPQ2d 1379, 1381 (B. Pat. App. & Int. 1989). Deeming the presence of a gap or clearance does not provide the requisite factual basis to support the presence of clearance angle α .

Assuming arguendo that it could be logically argued that '154 discloses a clearance angle having a value of zero, claim 1 now recites that clearance angle α has a value greater than zero. It cannot be logically argued that it would have been obvious to modify the "clearance angle" of '154 to be greater than zero in view of the

fact that such conventional devices have not adopted the subject configuration to attain the advantages discussed above. Therefore, the rejection of claim 1 under 35 U.S.C. § 103 must be withdrawn.

The various dependent claims add additional features to the independent claims, and are therefore believed to be allowable. Also, the dependent claims are believed patentably distinct on their own merits as being directed to combinations not suggested by the references.

The Office Action of October 25, 2002 alleged that the relative dimensions of the protrusions recited in claim 3 and the relative dimensions of the rods recited in claim 7 "are not considered to be a patentable distinction since the instant invention would not appear to function any differently than the '154 device." The Applicants' arguments filed 03/25/03 with respect to claims 3 and 7 showed that the relative dimensions cited in such claims did in fact cause the rods to function differently than the rods of the '154 device. Specifically, Applicants argued that "[t]he value of the protrusion dimensions recited in claim 3 and the rod dimensions recited in claim 7 have proven to provide a screen which has greater resistance to vibration. Accordingly, vibration related fatigue takes longer to develop and the screen has a longer lifetime than conventional screens." The Office Action of May 20, 2003 dismisses the Applicants' arguments filed 03/25/03 with respect to claims 3 and 7, reciting from paragraph 7.37 and additionally states that "Applicant argues that the values recited of the protrusion dimensions recited in claim 3 and the rod dimensions recited in claim 7 ... provide advantages over conventional screens, however, it is held that such modifications are obvious for the reasons set forth above." However, the reasons "set forth above" for rejecting claims 3 and 7 were that "relative dimensions are not considered to be a patentable distinction since the instant invention would not appear to function any differently than the '154 device." In other words, the Office Action of May 20, 2003 merely repeats (word for word) the earlier Office Action.


MPEP § 707.07(f) states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." MPEP § 707.07(f) also states that "[i]f it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised." It cannot possibly be said that the Office Action of May 20, 2003 "answers the substance" of Applicants' arguments filed 03/25/03 with respect to claims 3 and 7. Nor can it possibly be argued that the combination of the response to the Applicants' arguments and the rejections of claims 3 and 7 would show either the Applicants or the Board of Patent Appeals and

Interferences that the advantages asserted by the Applicants in response to the Office Action of October 25, 2002 "have actually been considered".

MPEP § 707.07(g) states that "[p]iecemeal examination should be avoided as much as possible." The examiner has rejected claims 3 and 7 on the basis that "relative dimensions are not considered to be a patentable distinction since the instant invention would not appear to function any differently than the '154 device." The Applicants have asserted that the relative dimension recited in claims 3 and 7 do indeed cause the instant invention to function differently than the '154 device. If the examiner believes that it would have been obvious to modify the '154 device to include the rods recited in claims 3 and 7 in order to achieve the asserted advantages, the examiner must make a prima facie case as to such obviousness. If the examiner questions the asserted advantages, he must specifically question the veracity of the asserted advantages and/or the form in which the asserted advantages were presented. If the examiner questions the asserted advantages and also believes that it would have been obvious to modify the '154 device in the manner recited in claims 3 and 7, he should state both objections to avoid piecemeal examination of the claims. In any case, the rejection of claims 3 and 7 may not be maintained merely on the basis that it did not appear that the relative dimensions would cause the '154 device to function differently.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
Helmuth Gabl

By 
Clifford P. Kelly
Registration No. 35,213
Alix, Yale & Ristas, LLP
Attorney for Applicant

750 Main Street
Hartford, CT 06103-2721
(860) 527-9211
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CPK/io